

## **REMARKS**

### **I. Status of the Application**

Claims 13-48 are pending in the application. Claim 25 has been amended to depend from claim 24 such that proper antecedent basis is provided for claim 25. Claims 49-63 have been added. The specification has been amended to include subject matter incorporated by reference in the provisional application no. 60/004,258 from which the present application claims priority including the two-step process of first applying an alkalizing agent to the tooth surface and then applying a tooth bleaching composition to the tooth. Support for these amendments and for all currently-presented claims is found throughout the specification of the provisional application. In particular, support is found at page 1, lines 22-23; page 2, lines 19-21; and page 2, line 24 to page 3, line 29 of Provisional Application Serial No. 60/004,258. No new matter is added by these amendments and additions. Attached hereto is a marked-up version of the changes made to the claims captioned "Version Of Amendments With Markings To Show Changes Made."

Applicant respectfully requests entry and consideration of the foregoing amendments, which are intended to place this case in condition for allowance.

### **II. The Claims as Currently Presented Do Not Result in Obviousness-Type Double Patenting.**

Claims 13 to 48 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17 to 41 of copending Application No. 10/039,935. Applicant respectfully traverses the rejection. That application, as well as the current application, claims priority from Provisional Application Serial No. 60/004,258, filed September 25, 1995. Claims 17 to 41 of the '935 application have been copied

into the present application as new claims 49 to 63 and cancelled from the '935 application, obviating the obviousness-type double patenting rejection.

**III. The Claims as Currently Presented Do Not Result in Statutory-Type Double Patenting.**

Claims 13 to 48 stand provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 17 to 41 of copending Application No. 10/039,935. Applicant respectfully traverses the rejection. That application, as well as the current application, claims priority from Provisional Application Serial No. 60/004,258, filed September 25, 1995. Claims 17 to 41 of the '935 application have been copied into the present application as new claims 49 to 63 and cancelled from the '935 application, obviating the statutory-type double patenting rejection.

**IV. Pending Claims 13-48 and New Claims 49-63 Meet the Requirements of 35 U.S.C. 112, First Paragraph.**

Claims 13 to 48 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. These claims further stand rejected under 35 U.S.C. 112, first paragraph, as not being enabled. Applicant respectfully traverses these rejections. Applicants further contend that new claims 49-63 meet the requirements of 35 U.S.C. 112, first paragraph.

The present application is a continuation of U.S. Patent Application Serial No. 10/000,658, filed October 31, 2001; which is a continuation of U.S. Patent Application Serial No. 09/374,172, filed on August 13, 1999; which is a continuation of United States Application

Serial No. 09/054,156, filed on April 2, 1998; which is itself a divisional of U.S. Patent Application No. 08/719,569, filed September 25, 1996, now U.S. Patent No. 5,922,307; which claims priority from Provisional Application Serial No. 60/004,258, filed September 25, 1995, each of which are incorporated by reference. The specification of the present application, which therefore includes the disclosure of Provisional Application Serial No. 60/004,258, provides adequate written description and enablement of the claims. Relevant portions of the specification of Provisional Application Serial No. 60/004,258 have been added by amendment to the specification of the current application, without adding any new matter, to demonstrate support for the claims.

**V. New Claims 49-63 Are Distinct as Against Claims 13-48.**

The Examiner, in making the above obviousness-type double patenting argument, indicated his contention that claims 13 to 48 are identical or similar to claims 17 to 41 of Serial No. 10/039,935, now presented as claims 49 to 63 in the present application. Applicant respectfully traverses this contention.

Independent claims 49 and 54 disclose methods for whitening teeth comprising the steps of applying to the teeth a composition comprising an *alkalizing agent having a pH* of between about 7 and about 10. Independent claims 13 and 18, on the other hand, disclose methods for whitening teeth comprising the steps of applying to the teeth a *composition having a pH* of between about 7 and 10 that comprises an alkalizing agent. The claims are distinct in that in one set it is the composition whose pH is specified, while in the other set it is the alkalizing agent for which the pH is specified.

**VI. Claims 13 to 48 and New Claims 49 to 63 Are Novel and Nonobvious Over Curtis et al., U.S. 6,174,516.**

Claims 13 to 48 stand rejected under 35 U.S.C. 102(a/e) as being anticipated by Curtis et al., U.S. 6,174,516, ("Curtis et al.") filed February 16, 1999. Claims 13 to 48 further stand rejected under 35 U.S.C. 103(a) as being obvious over Curtis et al. Applicant respectfully traverses these rejections and further contends that new claims 49 to 63 are novel and nonobvious over Curtis et al.

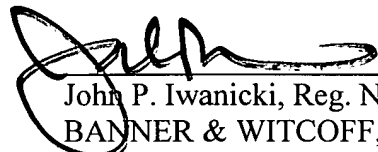
The present application is a continuation of U.S. Patent Application Serial No. 10/000,658, filed October 31, 2001; which is a continuation of U.S. Patent Application Serial No. 09/374,172, filed on August 13, 1999; which is a continuation of United States Application Serial No. 09/054,156, filed on April 2, 1998; which is itself a divisional of U.S. Patent Application No. 08/719,569, filed September 25, 1996, now U.S. Patent No. 5,922,307; which claims priority from Provisional Application Serial No. 60/004,258, filed September 25, 1995, each of which are incorporated by reference. The present application is therefore entitled to a filing date of September 25, 1995, or at a minimum of April 2, 1998, either of which precedes the February 16, 1999 filing date of Curtis et al. Therefore, Curtis et al. does not qualify as prior art for 102(a), 102(e) or 103(a) purposes. Applicant contends that the rejections are improper and respectfully requests that they be withdrawn.

**VII. CONCLUSION**

Reconsideration and allowance of all the pending claims and allowance of new claims 49 to 63 is respectfully requested. If a telephone conversation with Applicants' attorney would expedite prosecution of the above-identified application, the Examiner is requested to call the undersigned at (617) 227-7111.

Respectfully submitted,

Dated: February 10, 2003



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## Version Of Amendments With Markings To Show Changes Made

### In the Specification:

The paragraph beginning at page 5, line 20:

-- An important aspect of the present invention is the finding that the efficiency of the bleaching reaction in a tooth using a chemical tooth-bleaching agent such as a peroxide-containing or peroxide-releasing tooth bleaching composition, for example hydrogen peroxide can be significantly enhanced at a pH greater than 5.5, more particularly a pH in the range of 6-10, for example in a range of pH of 7-10, more particularly between 8.0 and 9.5, alternatively between pH of 7.5 and 9.0, providing that the pH is maintained at a substantially constant range throughout the tooth-bleaching process and a calcium chelating agent is included in the composition to prevent precipitation of calcium ions. (Table 1-4) --

### In the Claims:

25. (Amended) The method of claim [23] 24 wherein the alkalizing agent is selected from the group consisting of sodium hydroxide, sodium carbonate, and ammonium carbonate.